

## **REMARKS**

### **I. Introduction**

Pending claims 1-16 have been examined. Claim 11 is allowed and claim 16 is acknowledged to contain allowable subject matter. However, the Examiner rejects claims 1-10 and 12-15. Specifically, claims 1-10, 12-13 and 15 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 5,247,591 to Baran (hereinafter "Baran"). Claims 1-8, 12-13 and 15 stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 5,819,049 to Ogaki et al. (hereinafter "Ogaki"). Additionally, claim 14 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Baran in view of WIPO Publication No. WO 96/41463 to Geshwind (hereinafter "Geshwind").

As an initial matter, Applicant amends claim 15 and rewrites claim 16 in independent form. Furthermore, it is respectfully submitted that the rejections of claims 1-10 and 12-15 are overcome for at least the reasons set forth herein.

### **II. Allowable Subject Matter**

Claim 11 is allowed, and claim 16 should now also be allowed.

### III. Claim Rejections -- 35 U.S.C. § 102(b)

As noted above, claims 1-10, 12-13 and 15 stand rejected under § 102(b) as allegedly being anticipated by Baran.

#### A. Claims 1-10, 12 and 13

Claim 1 recites a system comprising a unique combination of features including, *inter alia*, a workflow control table which stores in advance the species, the destination, and the operation assigned to each operation document image. Baran fails to disclose or suggest such a system. For example, Baran fails to disclose or suggest a workflow control table that stores in advance the operation assigned to the operation document image.

The Examiner alleges, however, that Baran discloses the workflow control table of claim 1 by describing the setting up of a mailing list 30 by a user (*see* Office Action: pages 6 and 7; *citing* Baran: col. 4, line 66 to col. 5, line 30). In Baran, a user can use a form to associate a name and a telephone number to a specified abbreviation, wherein the abbreviations can thereafter be used to route fax messages (Baran: col. 4, line 60 to col. 5, line 30; and Fig. 3). In particular, a fax server can automatically convert a user inputted abbreviation, which is provided on a cover sheet of a fax message, into a corresponding telephone number (and extension) for routing the fax message (*Id.*). The use of abbreviations for a sender's and/or receiver's information on a fax cover sheet (*see, e.g.,* Baran: col. 5, lines 31-43) does not correspond storing in advance an operation assigned to an operation document image.

Furthermore, Baran discloses a fax mail form 204 that can be used as a cover sheet to send messages, wherein the form includes an action column for specifying certain actions with respect to a message, such as acknowledging that the message has been received, retaining the message, forwarding the message, replying to the message, erasing the message, etc. (Baran: col. 8, lines 3-56; and Fig. 9). The actions to be taken with respect to the message, however, are not stored in advance in a workflow control table. To the contrary, the actions to be taken are indicated by writing a letter in the action column of the form 204 (*Id.*). Thus, the actions to be taken with respect to a received message are recorded on the message itself in the form of one or more written letters. These letters must be recognized and processed upon receipt of the message to determine a corresponding operation to be performed.

In view of the above, Baran fails to disclose or suggest “a workflow control table that stores in advance ... the operation assigned to [the] operation document image,” as recited in claim 1. Therefore, it is respectfully submitted that claim 1 is not anticipated by Baran. Consequently, claims 2-10 are not anticipated by Baran at least by virtue of their dependency. Furthermore, claims 12 and 13 recite features similar to those recited in claim 1 and, thus, claims 12 and 13 are not anticipated by Baran based on a rationale analogous to that set forth above for claim 1.

*B. Claim 15*

Claim 15 recites features similar to those recited in claim 1 and, thus, claim 15 is not anticipated by Baran at least based on a rationale analogous to that set forth above for claim 1.

Furthermore, Applicant's claim 15 recites, *inter alia*, that the workflow control table stores in advance the species, the destinations, and the at least one operation for each destination assigned to the operation document image, wherein the destinations are ordered to define a predetermined path for transferring the operation document image. Thus, claim 15 requires a workflow control table that stores in advance the species of an operation document image, a plurality of destinations of the operation document image, and at least one operation for each of the destinations to be handled to the operation document image. Additionally, the plurality of destinations are ordered to defined a predetermined path for transferring the operation document image.

It is respectfully submitted that Baran fails to disclose or suggest a workflow control table that stores in advance a plurality of destinations for an operation document image, wherein the destinations are ordered to define a predetermined path for transferring the operation document image among the destinations.

#### **IV. Claim Rejections -- 35 U.S.C. § 102(e)**

As noted above, claims 1-8, 12-13 and 15 stand rejected under § 102(e) as allegedly being anticipated by Ogaki.

As noted above, claim 1 recites a system comprising a unique combination of features including, *inter alia*, a workflow control table which stores in advance the species, the destination, and the operation assigned to each operation document image. Ogaki fails to

disclose or suggest such a system. For example, Ogaki fails to disclose or suggest a workflow control table that stores in advance the destination of the operation document image.

The Examiner alleges, however, that Ogaki discloses the workflow control table of claim 1 by describing the circulation management table 80 (*see* Office Action: page 11; *citing* Ogaki: col. 6, line 37 to col. 7, line 10; and Fig. 10). In Ogaki, a document circulation sheet 31a has a region 36 for a user to list a plurality of destinations representing a circulation path of a document (Ogaki: col. 5, lines 36-50; and Fig. 4; *see also* Fig. 5). The list of destinations may be provided by the user through handwriting 39 (Ogaki: col. 4, lines 24-35; and Fig. 4). Alternatively, the destination information may be provided in a region 36 of a document circulation sheet 31b by typing the destination information using an input terminal and then printing out the document circulation sheet 31b on a printer 5 (Ogaki: col. 6, lines 1-9; and Fig. 5).

While the circulation management table 80 includes a field 87 for storing destination information (Ogaki: Fig. 10), the destination information is not stored in advance. To the contrary, the destination information is first recognized from the document circulation sheet 31a/31b (*e.g.*, by the sheet recognizing section 12) and then stored in the circulation management table 80 (Ogaki: col. 7, lines 9-10 and 54-58).

Thus, Ogaki fails to disclose or suggest a workflow control table that stores in advance the destination of the operation document image. Therefore, it is respectfully submitted that claim 1 is not anticipated by Ogaki. Consequently, claims 2-8 are not anticipated by Ogaki at

AMENDMENT UNDER 37 C.F.R. § 1.111  
U.S. Application No. 09/244,419  
Attorney Docket No. Q53219

least by virtue of their dependency. Furthermore, claims 12, 13 and 15 recite features similar to those recited in claim 1 and, thus, claims 12, 13 and 15 are not anticipated by Ogaki based on a rationale analogous to that set forth above for claim 1.

#### **V. Claim Rejections -- 35 U.S.C. § 103(a)**

As noted above, claim 14 stands rejected under § 103(a) as allegedly being unpatentable over Baran in view of Geshwind. It is respectfully submitted that Geshwind fails to cure the exemplary deficiencies of Baran, as set forth above with respect to claim 1 and, thus, claim 14 is patentable over the Examiner's proposed combination of Baran and Geshwind at least by virtue of its dependency.

#### **VII. Request for Acknowledgement of Consideration of Submitted References**

Applicant again respectfully maintains the request that the Examiner provide a signed and initialed copy of the Form PTO-1449 submitted with the IDS filed on April 27, 1999 to acknowledge consideration of the references cited therein.

#### **VII. Conclusion**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the

AMENDMENT UNDER 37 C.F.R. § 1.111  
U.S. Application No. 09/244,419  
Attorney Docket No. Q53219

Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned attorney at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



---

Billy Carter Raulerson  
Registration No. 52,156

SUGHRUE MION, PLLC  
Telephone: (202) 293-7060  
Facsimile: (202) 293-7860

WASHINGTON OFFICE

**23373**

CUSTOMER NUMBER

Date: August 18, 2004